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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,162	01/08/2004	Norman Gennaro	021756-088600US	1248
51206 7590 09/29/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER PARKER, BRANDI P				
ART UNIT 3624		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/755,162

Applicant(s)

GENNARO ET AL.

Examiner

BRANDI P. PARKER

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/3/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/3/2009 has been entered.

Acknowledgements

2. This is a non-final office action in response to the Applicant's Request for Continued Examination filed on 7/3/2009.
3. Claims 1-14 are pending in this Office Action. Claim 3 is cancelled. Claims 1, 2 and 8 are amended.

Response to Applicant's Amendments

4. Applicant's amendments to claims 1, 2 and 8 have been carefully considered, but are unpersuasive. The rejection of claims 1-14 under 35 U.S.C. 103 is maintained

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Based on Supreme Court precedent and recent Federal Circuit decisions, in order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

8. Claim 1 is directed towards computer-implemented method for a salesperson to track and identify sales opportunities within a sales territory. As the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state, the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101. Specifying a "computer-

implemented" is a nominal recitation and does not sufficiently tie the method to a particular machine or apparatus.

9. Whether a method appropriately includes particular machines to qualify as a section 101 process may not always be a straightforward inquiry. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007), (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (BPAI 2008-1495, 2008).

10. Claims 2 and 4-7 are rejected for being dependent upon rejected claim 1.

11. To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter). Applicant's invention in claim(s) 8 is directed towards software per se, which not statutory subject matter and therefore rejected under 35 U.S.C. 101.

12. Claims 9-14 are rejected for being dependent upon rejected claim 8.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (US 2002/0059095) in view of Johnson et al (US 6067525).

1. With respect to claim 1 and 8, Cook teaches:

a. providing, from customers of the salesperson within the sales territory, information regarding customers' needs and information regarding an install base of products and/or services of the customers, the provided install base information including origination information indicating those products and/or services that originate from an employer of the salesperson (paragraph 0002, 0005, and 0012, regarding customer lead data, including customer needs; paragraph 0011, regarding "e-brochure" containing information relating to the products or services that the company is promoting; paragraph 0045, regarding customer representative logs on to the Lead Management Intranet using passwords assigned by sales territory);

- b. from the provided customers' needs and install base information, tagging as sales opportunities those products and/or services offered for sale by the sales representative that match the customers' needs and those products and/or services of the customers' install base of products and/or services offered by the sales representative that the customers are likely to consider purchasing; storing the provided information in a central database that is controlled by the salesperson's employer and that is accessible over a computer network (paragraph 0006, regarding matching the customer's product/service need requirements to the products and services that the company provides, paragraph 0012, regarding presenting to the customer lead an optimized solution to their problems by listing a range of potential product/service solutions),
- c. formulating a search according to selected ones of a plurality of parameters related to customers in the salesperson's sales network and the products and/or services offered for sale by the salesperson (paragraph 0013, regarding searching the lead management database for customer information);
- d. applying the search to the central database (paragraph 0013, regarding searching the lead management database for customer information);

e. identifying results of the applied search, at least the sales opportunities, the customers' install base of products and/or services, the origination information and unknown information that identifies where the sales representative should gather additional install base information (paragraph 0013, regarding searching the lead management database for customer information); and

f. providing the results of the search and the identifying step in a tabular worksheet on a computer coupled to the network (paragraph 0045, regarding generated reports and tabulated information regarding product/service features).

Cook does not teach including in the base of information regarding the offered products and services those products and/or services that originate from competitors of the salesperson's employer. However, Johnson teaches presenting the company's product information side-by-side with a competitor's product information (column/line 12/43-46). It would have been obvious to one of ordinary skill in the art to include the business methods of Cook with the ability to view competitor product/service information as taught by Johnson since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

2. Regarding claims 2, 5-7, 9-10, and 12-14, Cook in view of Johnson teaches the system of claim 1 and providing the stored information in a tabular worksheet (paragraph 0045, regarding generated reports and tabulated information regarding product/service features). Cook in view of Johnson does not directly teach visually coding the tabular worksheet or customizing the appearance and ordering of entries in the worksheet, and limiting the results on information stored in the database. However, it is old and well known in the art to use spreadsheet applications, such as Microsoft Excel, to color-code and customize worksheets. Also, it is old and well known in the art to use a spreadsheet application such as Microsoft Excel to filter results in the spreadsheet based on a selected parameter. In the previous Office Action mailed 8/5/2008 and 2/3/2009, notice was taken by the Examiner that the above subject matter is old and well known in the art. Per MPEP 2144.03(c), these statements are taken as admitted prior art because no traversal of this statement was made in the subsequent response.

3. Therefore, it would have been obvious to one with ordinary skill in the art to include such features in the aforementioned claims in Cook to render the claims obvious, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

4. With respect to claims 4 and 11, Cook teaches the computer-implemented method of claim 1, wherein the provided information is selectively accessible, according to a sales hierarchy of the salesperson's employer (paragraph 0045, regarding access to the lead management intranet can be according to the levels of authority).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley B. Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624